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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/928,251	08/10/2001	Kevin J. Zwaert	MBHB 00-556-A	5656

7590

02/28/2003

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EXAMINER

WALCZAK, DAVID J

ART UNIT

PAPER NUMBER

3751

DATE MAILED: 02/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/928,251

Applicant(s)

ZWAERT ET AL.

Examiner

David J. Walczak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) 18-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group I, Species I in Paper No. 9 is acknowledged. The traversal is on the ground(s) that the two groups are not separable because they include "similar apparatus limitations" and the various species are not separable because "it is the claims, and not the figures that define the Applicant's invention" and "all of the species share the elements of claim 1 in common". This is not found persuasive because while both groups may include "similar apparatus limitation", the test for separating the groups (as discussed in the previous Office Action) is if the product as claimed can be used in a different process. As discussed previously, the claimed product can be used in a different process, such as a process which does not require the squeezing of a bottle (claim 18 calls for the squeezing of a bottle while claims 1-17 and 26-41 do not). Further, for the purposes of restriction, the claims do not define various species, but rather different species are always the specifically different embodiments (see MPEP806.04 (e)). Accordingly, the various embodiments disclosed in the specification define different species.

The Applicant has indicated that Group I (claims 1-17 and 26-41) and Species I (claims 1-25) are elected. Accordingly claims 1-17 will be examined herein (claims 26-41 will not be examined as they, as the Applicant contends, do not read on the elected species).

The requirement is still deemed proper and is therefore made FINAL.

Drawings

The drawings are objected to because reference character 87 (page 12, line 28) is not present in any of the drawings. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the brush and the pad (claims 3 and 14) must be shown or the features canceled from the claims. No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities: On page 9, line 27, "pin 64" should be --plug 64--, on page 10, lines 22-23, "second open end 68" should be --first open end 70--, on page 11, line 8, "threads 62" should be --threads 63-- and on page 14, lines 1 and 3, "110" (all three occurrences) should be --100--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In regard to claim 1, an antecedent basis for "the pin first open end" (line 6), "cap first opening" (line 7), "the pin second open end" (line 7) and "the cap second opening" (lines 7-8) should be defined (i.e., the pin has been defined as having "opening" while the cap has been defined as having "open ends", see lines 3 and 6). In regard to claim 2, on line 2, "cap second open end" should be --cap first open end-- as the applicator is positioned adjacent the first open end 70 (see page 10, line 22). In regard to claim 5, an antecedent basis for "the pin inner surface" (line 2) should be defined. In regard to claim 7, the recitation of "a first end" on line 3 is indefinite in that this first end has already been defined on line 2. Further, it appears that "the" should be inserted before "pin" on lines 2, 3 and 4 (all four occurrences). In regard to claim 8, an antecedent basis for "the threads on the resilient bottle neck outer surface" (lines 2-3) should be defined. In regard to claim 9, "pin" should be --the pin--.

UP In regard to claim 11, the cap first open end 70 is not annular wall as defined in the claim (see Figure 5A). In regard to claim 12, an antecedent basis for "the shoulder" (line 2) should be defined. Further, on line 2, "first opening" should be --second opening-- and on line 3, "cap" should be --the cap--. In regard to claim 13, on lines 8, 11 and 13, "the " should be inserted before --pin-- (all three occurrences), on line 10, -- and the second opening-- should be inserted after "between the shoulder" (see Figure

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4B), on lines 13 and 14, "the" should be inserted before "cap" (each occurrence) and on line 14, as discussed supra, the cap first open end 70 is not an annular wall as claimed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5 and 7-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Coombs. In regard to claim 1, Coombs discloses a liquid applicator comprised of a resilient bottle 12 adapted to hold a liquid and having an opening, a pin 30 having first and second openings and at least partially surrounding the bottle wherein the bottle opening is concentric to the pin second opening, a cap 13 including first and second open ends wherein the open ends are arranged as claimed and an applicator holder 11. In regard to claims 2 and 3, Coombs discloses a roller applicator 21 positioned adjacent to the cap open end. In regard to claims 4 and 5, the bottle includes a threaded neck 33 between the hollow body and the opening thereof wherein the threaded neck engages a threaded inner surface of the pin. In regard to claims 7 and 8, the pin includes an annular wall having threads 32 thereon which mate with the threaded neck of the bottle and a shoulder (located beneath the threads 32, see Figure 3) dividing the first and second openings. In regard to claims 9 and 10, the Coombs device includes a plug 35 "associated" with the pin openings and having an outer diameter smaller than the

diameter of the cap second open end. In regard to claims 11 and 12, the cap includes a threaded annular wall 29 which receives the threaded neck 31 of the pin. In regard to claims 13-15, as discussed supra, the Coombs device includes the claimed structure. In regard to claim 16, the bottle has an opening that is "large enough to allow the resilient bottle to be filled".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coombs. Although the Coombs reference does not disclose the specific material used to make the pin or the dimensions of the bottle opening, it is the Examiner's position that it would have been obvious to one of ordinary skill in the art at the time the invention was made that the pin can be made of any suitable material, including a rigid plastic and the bottle opening can be of any suitable size, including the claimed size, without effecting the overall operation of the device.

Conclusion


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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The White, Sr., Lampert, Gentile et al., Goncalves and Benkowski references are cited for disclosing other roller applicators.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Walczak whose telephone number is 703-308-0608. The examiner can normally be reached on Mon-Thurs, 6:30- 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg L. Huson can be reached on 703-308-2580. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.



David J. Walczak
Primary Examiner
Art Unit 3751

DJW
February 26, 2003